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PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q62422

Yusuke KIMATA, et al.

Appln. No.: 09/739,619

Group Art Unit: 2643

Confirmation No.: 4741

Examiner: Ramakrishnaiah, M.

Filed: December 20, 2000

For: PICTURE-PHONE DEVICE PROVIDING MEANS FOR GUIDING OPERATOR'S LINE  
OF SIGHT TO SPECIFIC DIRECTION THEREIN

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

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Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated May 27, 2004. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

The Examiner raises several new points of argument in the Examiner's Answer that Appellants address herein.

**I. Summary of Invention**

The Examiner alleges that the Summary of the Invention contained in Appellants' Brief on Appeal "is deficient because it is not a summary of the appellant's invention, but rather a

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description of the drawings.”<sup>1</sup> Appellants disagree. The Summary of the Invention section of Appellants’ Brief on Appeal<sup>2</sup> meets the conditions of 37 C.F.R. § 1.192(c)(5), which clearly set out the requirements of the Summary of the Invention Section of a Brief on Appeal.<sup>3</sup> Further, Appellants’ references to the drawings in the Summary of the Invention section of Appellants’ Brief on Appeal, are appropriate in view of the requirement that the Summary of the Invention section of a Brief on Appeal refer to drawings, “if any, by reference characters.”<sup>4</sup>

Regarding the Examiner’s allegation that “[t]he real summary of the invention is shown on pages 3-4 of the appellant’s specification,”<sup>5</sup> Appellants submit that the summary contained at pages 3-4 of Appellants’ specification is a summary directed to meet the conditions of 37 C.F.R. § 1.73 and MPEP 608.01(d), which set out the requirements of a summary contained within an application.<sup>6</sup> Appellants note that the requirements of a summary contained within an application and those of a Summary of the Invention section contained within a Brief on Appeal

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<sup>1</sup> Examiner’s Answer, p. 2.

<sup>2</sup> Appellants’ Brief on Appeal, p. 2-4.

<sup>3</sup> “*Summary of the Invention*. A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.” 37 C.F.R. § 1.192(c)(5).

<sup>4</sup> *Id.*

<sup>5</sup> Examiner’s Answer, p.2.

<sup>6</sup> “A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.” 37 C.F.R. § 1.73. *See also* MPEP 608.01(d).

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are different requirements which Appellants have met separately in the summary contained in Appellants' specification and in the Summary of the Invention section of Appellants' Brief on Appeal.

**II. Prior Art of Record**

In the Prior Art of Record section of the Examiner's Answer, the Examiner incorrectly cites the patent number of the Ota reference. The correct prior art of record is:

- i) Hiroaki et al., U.S. Patent No. 5,786,846, July 28, 1998 ("Hiroaki").
- ii) Ota, JP 63276352, November 14, 1988 ("Ota").
- iii) Leppisaari et al., EP 0884905, December 16, 1998 ("Leppisaari").
- iv) Kobayashi, JP 356152387, November 25, 1981 ("Kobayashi").

**III. Grounds of Rejection**

In the Grounds of Rejection section of the Examiner's Answer<sup>7</sup>, the Examiner repeats, verbatim, the rejections presented in each of the Office Actions, dated May 24, 2002, December 10, 2002, May 19, 2003, and January 12, 2004. In response to the Examiner's arguments presented in this section, Appellants refer to the responses presented in the Amendment filed August 22, 2002, the Response filed February 28, 2003, and Appellants' Brief on Appeal.

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<sup>7</sup> Examiner's Answer, p. 3-9.

#### **IV. Response to Argument**

##### **A. Group I**

1. In response to Appellants' arguments regarding the claimed limitation of "means for guiding the operator's line of sight toward said imaging portion,"<sup>8</sup> the Examiner alleges that "Hiroaki clearly indicates his system is designed to provide face to face conversation which means line of sight is maintained between the participants of the video conference by remaining in the shoot range of the camera."<sup>2</sup> The Examiner further alleges that Hiroaki "discloses that his system promotes smooth and natural communication with the remote user," that "smooth and natural communication means eye contact," and that "Hiroaki further refers to people having normal conversation with the other by facing and eye contacting with each other."<sup>10</sup> Appellants respectfully submit that these allegations are without merit.

Appellants agree that Hiroaki describes that an object of the invention is face to face conversation<sup>11</sup> and that Hiroaki discloses that the invention is directed to allowing a local user to operate a terminal "within the shoot range of the camera, resulting in smooth and natural

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<sup>8</sup> Appellants' Brief on Appeal, p. 6-9.

<sup>2</sup> Examiner's Answer, p. 10, *see also* p. 11 (first and second paragraphs), 12, and 14.

<sup>10</sup> Examiner's Answer, p. 14, *see also* p. 11 (first and second paragraphs) and 12-13.

<sup>11</sup> Hiroaki, col. 3, lns. 20-26.

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communication.”<sup>12</sup> Appellants also agree that Hiroaki discloses that “[g]enerally the people has a normal conversation with the other by facing and eye contacting with each other.”<sup>13</sup> However, there is no disclosure, teaching, or suggestion in Hiroaki of maintaining a line of sight between participants of a video conference or of directing an operator’s line of sight to an imaging portion (camera), and, moreover, these limitations are not necessarily or inherently disclosed by the description in Hiroaki of a user repositioning himself in order to remain within the shoot range of the camera.

Evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”<sup>14</sup> “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.”<sup>15</sup> Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art

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<sup>12</sup> Hiroaki, col. 1, lns. 8-13.

<sup>13</sup> *Id.* col. 17, lns. 2-4.

<sup>14</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

<sup>15</sup> *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (*quoting Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (*emphasis in original*); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

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disclosure.<sup>16</sup> Thus, guiding an operator's line of sight towards an imaging portion (camera), is not inherent in Hiroaki's disclosure that an object of the invention is face to face conversation by directing a user to remain within the shoot range of the camera. As discussed in Appellants' Brief on Appeal, the line of sight of the operator is not the same as the physical position of the operator with respect to the shoot range of a camera, and an operator could easily be situated within the shoot range of a camera, and yet, not be looking at the camera.<sup>17</sup>

Regarding Hiroaki's discussion of "smooth and natural communication," Appellants submit that there is no definition or description of "smooth and natural conversation" in Hiroaki, and therefore no disclosure, teaching, or suggestion that "smooth and natural conversation" means that an operator's line of sight would be directed to an imaging portion.

Regarding the "normal conversation" referred to by the Examiner, it is clearly disclosed in Hiroaki that the "normal conversation" referred to is one in which both conversationalists can see each other.<sup>18</sup> Hiroaki describes that, in contrast, "unnatural communication" is created when only one user can see the other's image.<sup>19</sup>

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<sup>16</sup> See *Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

<sup>17</sup> See Appellants' Brief on Appeal, p. 8-9.

<sup>18</sup> *Id.* col. 17, lns. 6-38.

<sup>19</sup> *Id.* col. 17, lns. 13-16.

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Even if, *arguendo*, Hiroaki taught that a goal of the invention was to have users maintain eye contact with one another, the only disclosure, teaching, or suggestion in Hiroaki of how this goal could be accomplished, is through the above-mentioned direction to a user to remain within the shoot range of a camera. As discussed, this means is not equivalent to, nor does it inherently disclose guiding an operator's line of sight towards an imaging portion, as claimed.

2. Regarding the Examiner's allegation that "it was disingenuous for the Appellant to make this argument [that based on the disclosure of Hiroaki, which describes indicators on the screen directing the operator to move his body, it would be natural for the operator to have his line of sight directed to the screen, so that he can identify in which direction he should move] in that his invention also displays an arrow for directing the caller's line of sight to the direction of the camera," Appellants respectfully disagree.

Appellants intended no disingenuity in the presentation of the above-mentioned argument. In fact, the above-mentioned argument supports Appellants contention that the description in Hiroaki of a system and method in which a user is directed to reposition himself within a shoot range of a camera fails to inherently disclose guiding an operator's line of sight towards an imaging portion. Appellants additionally provided further support for this contention.<sup>20</sup> What may or may not be inherent from the disclosure of Appellants' specification is not at issue.

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<sup>20</sup> See *e.g.* Appellants' Brief on Appeal, p.8-9.

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3. Regarding the Examiner's allegation that "appellant constantly harps on operator moving his body ... as if user of the Hiroaki system has no face and only body," and that as the user of the Hiroaki system is directed to move his body within the shoot range of the camera "inherently user's face is in shoot range of the camera,"<sup>21</sup> Appellants respectfully submit that it would be absurd to imply that a user of the Hiroaki system lacked either a face or a head.

The discussion in Appellants' Brief on Appeal of Hiroaki's description of a user being directed to move his body in a direction in order to come within the shoot range of a camera is clearly directed to the Examiner's own assertions that the portions of Hiroaki which discuss this direction disclose guiding an operator's line of sight towards an imaging portion, as claimed.<sup>22</sup> Appellants agree with the Examiner's descriptions of Hiroaki to the extent that Hiroaki teaches that when the local user deviates from the shoot range, he is directed to move into the shoot range. However, as discussed above, Appellants disagree that this teaching anticipates guiding an operator's line of sight toward an imaging portion, as claimed.

4. Regarding the Examiner's allegations that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

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<sup>21</sup> Examiner's Answer, p. 13.

<sup>22</sup> See Examiner's Office Actions dated May 24, 2002, December 10, 2002, May 19, 2003, and January 12, 2004. See also Examiner's Answer, p. 3, 5, 6, 8, and 9.



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references,”<sup>23</sup> Appellants respectfully disagree with the Examiner’s interpretation of Appellants’ Arguments.

Appellants note that the portions of Appellants’ Brief on Appeal to which the Examiner refers<sup>24</sup> is a discussion of how none of the cited references remedies the previously discussed deficiencies of the main reference.<sup>25</sup>

5. Accordingly, the Board should reverse the rejection of the claims of Group I since the Examiner’s allegations are merely argumentative and fail to present a *prima facie* case of anticipation.

**B. Group II**

1. Regarding the Examiner’s assertion that Ota discloses “controlling indicating means in response to a result of whether the picture-phone is in use or not according to a voice input signal output from a microphone,” as recited in each of claims 3, 12, and 18, Appellants respectfully disagree.

The Examiner’s description of Ota<sup>26</sup> is correct. According to the disclosure of Ota, the name of a third party, spoken by an operator, is recognized by a telephone terminal, which, in

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<sup>23</sup> Examiner’s Answer, p. 15, 16, and 17.

<sup>24</sup> Appellants’ Brief on Appeal, p. 9-12.

<sup>25</sup> *Id.* p. 5-9.

<sup>26</sup> Examiner’s Answer, p. 18.

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response, analyses the voice pattern, and retrieves and displays information relating to the third party. However, the Examiner's reasoning that analyzing a voice pattern and recognizing a spoken name anticipates determining whether a picture-phone is in use or not according to a voice input signal is misplaced. The Examiner mistakenly interprets the phrase "in use" to mean whether the phone is on.

As further clarification of the claimed limitation, Appellants submit that one of ordinary skill in the art, in reading the entire claim limitation would understand that the limitation indicates that the control means controls the indicating means, which guides the operator's line of sight, in response to a voice input signal. According to the voice input signal, a determination is made as to whether the picture phone is in use. In other words, when the operator is speaking, and thus inputting a voice signal, it is determined that the phone is in use, and the control means turns on the indicating means to tell the operator that when he is speaking, he should look at the camera. The phone is determined to be "in use" when the operator is speaking.

In contrast, Ota merely discloses recognizing a spoken third party name and displaying information in response to the spoken name. Ota fails to teach or suggest controlling an indicating means in response to a voice input signal indicating that a picture-phone is in use, as claimed.

2. Accordingly, the Board should reverse the rejection of the claims of Group II since the Examiner's arguments fail to present a *prima facie* case of obviousness.

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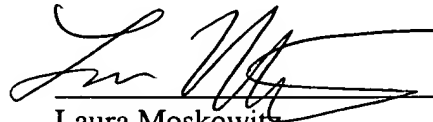
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**CONCLUSION**

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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